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CORNING, NY 14831

EXAMINER

CHUNG, HO-SUNG

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JIANGWEI FENG, TODD M. HARVEY,
SHRISUDERSAN JAYARAMAN, and
LJERKA UKRAINCZYK

Appeal 2016-001614
Application 13/084,802
Technology Center 1700

Before TERRY J. OWENS, JAMES C. HOUSEL, and
AVELYN M. ROSS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–9, 11, 13–15 and 17–19. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim a method for stripping a partially oxidized nitride release coating from a metal workpiece. Claim 1 is illustrative:

1. A method for stripping a partially oxidized nitride release coating from a metal workpiece comprising the steps of:
 disrupting a surface oxidation layer on the release coating to increase release coating electrical conductivity, and

flowing an electrical current from the workpiece and release coating to a counter electrode while the workpiece, release coating and counter electrode are immersed in an aqueous alkaline electrolyte solution.

The References

Hagerty	US 4,747,864	May 31, 1988
Sato	US 5,723,174	Mar. 3, 1998
Hayakawa	US 2005/0263806 A1	Dec. 1, 2005
Moore	US 2005/0268662 A1	Dec. 8, 2005
Mishra	US 2006/0226025 A1	Oct. 12, 2006
Lung	US 2007/0186589 A1	Aug. 16, 2007

Kawamura (human translation) JP 2000-44259 A Feb. 15, 2000

J.J. Sun et al., *MREF-ECM process for hard passive materials surface finishing*, 108 *J. Matl. Proc. Tech.* 356–68 (2001) (hereinafter Sun).

The Rejections

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 2, 4–9, and 11 over Mishra in view of Kawamura, claim 3 over Mishra in view of Kawamura, Sato and Hagerty, claims 13 and 17 over Mishra in view of Kawamura and Moore, claim 14 over Mishra in view of Kawamura and Lung, claim 15 over Mishra in view of Kawamura, Moore, Lung and Hagerty, claim 18 over Mishra in view of Kawamura and Hayakawa, and claim 19 over Mishra in view of Kawamura, Moore and Sun.

OPINION

We reverse the rejections. We need address only the independent claims (1 and 19). Those claims require stripping a partially oxidized nitride release coating from a metal workpiece by a method comprising disrupting a surface oxidation layer on the release coating to increase release coating electrical conductivity, and flowing an electrical current from the workpiece

and the release coating to a counter electrode. To meet that claim requirement the Examiner relies upon the combination of Mishra and Kawamura (Final Act. 3–5).

Mishra substantially removes a metallic carbide or nitride coating from a metal workpiece by passing a current over an electrochemical cell comprising an anode (which can be the workpiece) and a cathode in an acidic or basic aqueous electrolyte (¶¶ 8–10).

Kawamura removes an oxide coating from molding tool faces by rubbing the faces with a soft abrasive member holding abrasive grains (¶ 12).

The Examiner concludes that “it would have been obvious to a person having ordinary skill in the art at the time of the invention to have sanded away Mishra in view of Kawamura’s oxidation layer in order to remove the deterioration as taught by Kawamura. Doing this would inherently increase release coating electrical conductivity” (Final Act. 5; *see also* Ans. 5–6).

Setting forth a *prima facie* case of obviousness requires establishing that the applied prior art would have provided one of ordinary skill in the art with an apparent reason to modify the prior art to arrive at the claimed invention. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Mishra and Kawamura disclose alternative methods for removing coatings. The Examiner does not establish that Mishra and Kawamura would have provided one of ordinary skill in the art with an apparent reason to use Kawamura’s method to disrupt an oxidation layer on Mishra’s workpiece, followed by use of Mishra’s electrolysis method. Thus, the rejections appear to be based on impermissible hindsight in view of the Appellants’ disclosure. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA

1967) (“A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art”).

Accordingly, we reverse the rejections.

DECISION/ORDER

The rejections under 35 U.S.C. § 103 of claims 1, 2, 4–9, and 11 over Mishra in view of Kawamura, claim 3 over Mishra in view of Kawamura, Sato and Hagerty, claims 13 and 17 over Mishra in view of Kawamura and Moore, claim 14 over Mishra in view of Kawamura and Lung, claim 15 over Mishra in view of Kawamura, Moore, Lung and Hagerty, claim 18 over Mishra in view of Kawamura and Hayakawa, and claim 19 over Mishra in view of Kawamura, Moore and Sun are reversed.

It is ordered that the Examiner’s decision is reversed.

REVERSED